REMARKS

Applicants have reviewed and considered the Office Action mailed on May 12, 2006. Claims 16-32 are currently pending. Claims 16 and 27 are amended. The amendments contain no new matter and are fully supported by Applicants' original specification, including the original drawings and claims, such as page 16, lines 19-21. Applicants respectfully request reconsideration and allowance of the claims in view of the following remarks.

Claims 16-21 and 24-32 are Patentable over Fries and Alexander under §103

Claims 16-21 and 24-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,317,885 to Fries ("Fries") in view of U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander").

According to MPEP §2143, to establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Fries and Alexander fails to establish a *prima facie* case of obviousness, because the combination fails to teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest the claimed option for storing the interactive advertisement on a user-defined storage device.

Claim 16 recites, *inter alia*, "presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing."

Fries fails to teach the claimed option for storing an interactive advertisement on a user-defined storage device. (See Office Action, page 3.)

Alexander fails to teach or suggest the claimed option for storing an interactive advertisement on a user-defined storage device. By contrast, Alexander teaches that the user presses a record button to instruct the EPG to record an infomercial or advertisement to that extent that it is scheduled for a future time, i.e., it is broadcast at a time or on a channel that would be inconvenient for the viewer to watch in real-time. (See Alexander, col. 19, lines 57-65.) Thus, the storage device is not user-defined and the recording in Alexander is under the control of the EPG, not the user. In addition, the claimed invention presents an option to store an interactive advertisement that is being presented, not one scheduled for a future time, as in Alexander. The claimed invention provides more user-control and allows storage of any interactive advertisement being presented, not only ones scheduled for a future time.

Therefore, claim 16 is patentable over the combination of Fries and Alexander under §103.

Claims 17-26 depend, directly or indirectly, from claim 16 and, thus, inherit the patentable subject matter of claim 16, while adding additional elements and further defining elements. Therefore, claims 17-26 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 16.

Claim 27 recites, *inter alia*, "a user-defined storage device for storing the interactive advertisement, when the user selects an option to store the interactive advertisement for future viewing, during the presentation of the interactive advertisement." For the same reasons given above with respect to claim 16, claim 27 is patentable over the combination of Fries and Alexander under §103.

Claims 28-32 depend, directly or indirectly, from claim 27 and, thus, inherit the patentable subject matter of claim 27, while adding additional elements and further defining elements. Therefore, claims 28-32 are also patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 27.

Claims 22 and 23 are Patentable over Fries, Alexander, Lawler, and Matthews under §103

Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fries in view of Alexander, in further view of U.S. Patent No. 5,699,107 to Lawler et al. ("Lawler"), and in further view of U.S. Patent No. 6,025,837 to Matthews ("Matthews").

Claims 22 and 23 are patentable over the combination of Fries and Alexander under §103 for at least the reasons given above with respect to claim 16. Lawler and Matthews also fail to teach or suggest the claimed option for storing the interactive advertisement on a user-defined storage device. Therefore, claims 22 and 23 are patentable over the combination of Fries, Alexander, Lawler, and Matthews under §103.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea Nicholson or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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